



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/553,633

11/07/2006

Songtao Shi

4239-81540-05

4649

36218 7590 05/19/2011
KLARQUIST SPARKMAN, LLP (OTT-NIH)
121 S.W. SALMON STREET
SUITE #1600
PORTLAND, OR 97204-2988

EXAMINER

FALK, ANNE MARIE

ART UNIT

PAPER NUMBER

1632

NOTIFICATION DATE

DELIVERY MODE

05/19/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tanya.harding@klarquist.com
docketing@klarquist.com

Interview Summary	Application No. 10/553,633	Applicant(s) SHI ET AL.
	Examiner Anne-Marie Falk, Ph.D.	Art Unit 1632

All participants (applicant, applicant's representative, PTO personnel):

(1) <u>Anne-Marie Falk, Ph.D.</u>	(3) _____.
(2) <u>Susan Alpert Siegel, Ph.D.</u>	(4) _____.

Date of Interview: 16 May 2011.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____.

Claim(s) discussed: 59, 110, and 111.

Identification of prior art discussed: None.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

/Anne-Marie Falk/ Primary Examiner, Art Unit 1632	
--	--

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

The Attorney contacted the Examiner to request withdrawal of the finality of the last Office action. The Examiner explained that the action was properly made final and therefore the finality will not be withdrawn. The Examiner explained in detail the reasons why the action was properly made final. In particular, the Examiner explained that the rejection of record was maintained and that no new rejections were made. Additionally, the two new claims both depend from Claim 59 which recites the new matter that is the subject of the rejection of record. Additionally, no arguments were provided to explain why the new claims overcome the new matter issue. The Attorney complained that the Examiner did not provide an additional interview before the issuance of the Office action and the Examiner pointed out that two after final interviews had already been given, including consideration of a draft amendment and full response, extensive discussions pertaining thereto, and additional proposed amendments considered in a second interview. A third after final interview was not warranted. The Examiner noted that hopefully the two interviews granted gave the Attorney some direction to proceed with her next response. At that point, additional interviews are not warranted prior to the issuance of the next Office action.

The Attorney emphasized that the new claims recite the deposited cells, but the Examiner reminded the Attorney that the claims are not directed to the deposited cells per se, but instead are directed to cells that have the "characteristics" of the deposited cells, including specifically the properties recited in Claim 59. The Examiner reminded the Attorney that cells having the properties recited in Claim 59 are not described in the specification. That is why there is a new matter rejection. The Attorney next inquired into whether they would be able to get an allowance if the claim was presented as an independent claim. The Examiner pointed out that the Applicant would need to clarify which cells were deposited, since Applicants have argued that the 11 separate claims to the cells are all directed to subpopulations and therefore are all distinct cell types, not duplicate claims claiming the same cells in 11 different ways. The Attorney stated that the cells deposited are the cells described in the specification. However, the Examiner alerted the Attorney again to the disclosure of multiple cell types. Since multiple cell types are disclosed and claimed, Applicants must specify which cells were deposited. The Attorney stated that she did not know which cells were deposited and would find out from the inventor. The Examiner advised the Attorney to point to the cells by page and line number in her next response. The Attorney requested an additional interview with the Examiner and her supervisor to discuss proposed new claims directed to the deposited cells. The Attorney agreed to find out which cells were deposited and the Examiner agreed to schedule an interview for next week or the week thereafter to give the Attorney time to get in touch with the inventors.